

**REMARKS**

By this amendment, claims 10-18 are added for examination. Therefore, on entering this Amendment, claims 1-9 are pending in the application.

Claims 7-9 are rejected under directed to non-statutory subject matter.

Claims 7-9 are rejected under 35 U.S.C. 101 as being directed to non statutory subject matter.

Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Nanbu et al., U.S. Paten No. 6,970,754.

The Applicants traverse the rejections and request reconsideration.

***Claim Rejections Under 35 U.S.C. § 101***

The Applicants respectfully amend claims 7-9 to recite a computer program product in a form that has become commonly acceptable as an *In Re Beauregard* claim.

***Claim Rejections Under 35 U.S.C. 102(e)***

**Rejection of claims 1-9 as being anticipated by Nanbu et al.**

Applicants respectfully submit that the Examiners rejections are not well-founded. Examiner merely makes a reference to Figures 1 and 20-43 of Nanbu et al. (US 6,970,754) and concludes that all the features of claims 1-9 are adequately disclosed, or rendered inherent. The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. *See* MPEP 706. The Examiner is required to explain the pertinence of each reference clearly. *Id.* The Examiner has merely pointed out broad sections of the Specification of Nanbu, without clearly pointing out where each element of the claimed

invention is disclosed by Nanbu. Therefore, the Examiner has not satisfied his burden in establishing *prima facie* anticipation of the present invention

Further, Nanbu fails to disclose all the features required by the independent claims 1, 4 and 9, For example, although Nanbu discloses an automatic designing apparatus 132 (see, e.g., Fig. 1 and Nanbu), this automatic designing apparatus 132 of Nanbu achieves the automatic designing by retrieving information from the database 105 (see col. 15, lines 50-52 of Nanbu). Nowhere in the disclosure of Nanbu is there a teaching related to computing output value information as required by the respective independent claims.

Retrieving design information from a database, as in Nanbu, is completely different from computing output value information as in the present invention. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Examiner has not established *prima facie* anticipation of the present invention by Nanbu at least because of the above-noted differences.

### ***New Claims***

The Applicants respectfully add dependent claims 10-18 for examination. These claims are supported at least by the disclosure on, page 25, line 9 through page 26, line 7 and Figures 10 and 14 of the application.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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